

PATENT

**UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Stephen Griffin et al. Confirmation No.: 1334  
Serial No.: 10/729,742 Examiner: Jeffrey G. Hoekstra  
Filing Date: December 5, 2003 Group Art Unit: 3736  
Docket No.: 1001.1727101 Customer No.: 28075  
For: GUIDE CATHETER WITH REMOVABLE SUPPORT

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**CERTIFICATE FOR ELECTRONIC TRANSMISSION:**

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 16th day of November 2007.

By

  
Kathleen L. Boekley

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached four sheets of arguments.

This Request is signed by an attorney or agent of record.

Respectfully submitted,

Stephen Griffin et al.

By their Attorney



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Date:

11/16/07

Attachment: Four Sheets of Pre-Appeal Conference Brief

UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No.: 10/729,742 Examiner: Jeffrey G. Hoekstra  
Filing Date: December 5, 2003 Group Art Unit: 3736  
Docket No.: 1001.1727101 Customer No.: 28075  
For: GUIDE CATHETER WITH REMOVABLE SUPPORT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
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PRE-APPEAL CONFERENCE BRIEF**CERTIFICATE FOR ELECTRONIC TRANSMISSION:**

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 16th day of November 2007.

By

  
Kathleen L. Boekley

Dear Sir:

Applicants have carefully reviewed the Final Office Action dated September 17, 2007. Claims 1-9 and 11-21 are pending. Claims 1-7, 9 and 11-21 stand rejected in the application while claim 8 is withdrawn from consideration. Applicants hereby request a pre-appeal conference and file this pre-appeal conference brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested. Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a *prima facie* rejection.

Claims 1-7, 9-10, 14-15, 18 and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Furnish, U.S. Patent No. 6,873,868. In order to anticipate, the cited reference must disclose each and every claimed element. Furnish fails to do so.

It is noted that independent claim 1 recites "removable support means for providing column support to the elongate shaft." In examining claim limitations evoking a mean-plus-function evaluation, a two-step process must be conducted. First, the element found in the prior art must perform the same function specified in the claim. Second, the structure of the prior art element must be found to perform the function in substantially the same way while producing

substantially the same results as the corresponding element disclosed in the specification. See M.P.E.P. §§2181-2184. The Examiner has repeatedly ignored these requirements, asserting instead that independent claim 1 is not entitled to a means-plus-function interpretation. This is an error made by the Examiner.

The Examiner has asserted (see page 6 of the instant Office Action) that claim 1 is not entitled to a means-plus-function interpretation because the “removable support means for providing column support to the elongate shaft” are referred to in subsequent claims as “the removable support means” and because the “anchoring means for securing the removable support means” are referred to in subsequent claims as “the anchoring means”. Applicants believe that the claims as pending properly employ means-plus-function terminology and thus appropriately invoke 35 U.S.C. §112, 6<sup>th</sup> paragraph. Therefore, the Examiner has no appropriate or reasonable basis for not examining the pending claims under the requirements of 35 U.S.C. §112, 6<sup>th</sup> paragraph. Thus, the Examiner has made an error in not evaluating these claims using the two-step process noted above.

If the claims are properly examined, it is clear that Furnish cannot be considered as anticipating claim 1 (and hence claims 2-7 depending therefrom). As discussed previously, it appears that the Examiner is incorrectly relying upon the signal fiber (130) of Furnish as being equivalent to the removable support means. In order to show equivalence, it must first be demonstrated that the signal fiber (130) of Furnish performs the same function as the claimed limitation. This requirement has not been met.

Signal fiber (130) is disclosed as a signal fiber for delivering or receiving beams of light energy (see Furnish at column 10, lines 9-11). There is no suggestion or disclosure that the signal fiber (130) performs the function of a removable support means for providing column support to the elongate shaft. Moreover, the Furnish signal fiber (130) is not an equivalent structure that performs the function in substantially the same way while producing substantially the same results as the corresponding element disclosed in Applicants' specification.

With respect to independent claim 9, Applicants note that the claim requires that each of the support tracks have a cross-sectional profile configured to permit each of the support ribs to move axially with respect to each support track while limiting relative radial movement. Furnish does not disclose this, despite the Examiner's assertions to the contrary.

At page 7 of the instant Office Action, the Examiner has asserted that “Furnish shows support tracks having a complementary cross-sectional profile to the support means, said cross-sectional profile capable of permitting the removable support means to move axially with respect to the elongate shaft while limiting relative radial movement.” This is incorrect. The alignment grooves disclosed by Furnish may limit relative circumferential movement. The alignment grooves are not appropriately configured and thus cannot reasonably be considered as limiting (or being capable of limiting) relative radial movement. This is a claimed feature expressly missing from the cited reference.

Moreover, it is noted that claim 9 recites “a plurality of support tracks disposed on the external surface of the elongate shaft”. Applicants do not believe that an alignment groove formed within an outer surface of a shaft is equivalent to a support track that is disposed on the shaft. Claim 9 also recites “a plurality of support ribs that are configured to be removable disposed over at least a portion of the plurality of support tracks”. Applicants do not believe that a signal fiber extending within an alignment groove qualifies as a support rib that is disposed over at least a portion of a support track. In any event, Applicants do not concede that a signal fiber qualifies as a support rib.

As discussed above, a proper examination of claim 1 reveals that claims 1-7 recite limitations that are not shown by Furnish. Claim 9 (and hence claims 11-21 depending therefrom) recites structural elements that are not shown by Furnish. Thus, the claimed invention is patentable over Furnish. Favorable reconsideration is respectfully requested.

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furnish in view of Rammler, U.S. Patent No. 5,327,891. Claim 9, from which claims 11-13 depend and further limit, is distinguished above as being patentable over Furnish. Rammler is not believed to remedy the noted shortcomings of Furnish, particularly as Rammler is not believed (see Amendment filed July 10, 2006) to describe or suggest any structure that provides column support. Thus, claim 9 is patentable over the cited combination of Furnish and Rammler. As claims 11-13 include the elements of claim 9 and add further limitations, claims 11-13 are patentable. Favorable reconsideration is respectfully requested.

Claims 16-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furnish in view of MacDonald et al., U.S. Patent No. 6,210,396. Claim 9, from which claims 16-17 depend and further limit, is distinguished above as being patentable over Furnish. MacDonald et

al. are not believed to remedy the noted shortcomings of Furnish. Thus, claim 9 is patentable over the cited combination of Furnish and MacDonald et al. As claims 16-17 include the elements of claim 9 and add further limitations, claims 16-17 are patentable. Favorable reconsideration is respectfully requested.

Claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Furnish in view of Rammler. Claim 9, from which claims 19-20 depend and further limit, is distinguished above as being patentable over Furnish. Rammler is not believed to remedy the noted shortcomings of Furnish. Thus, claim 9 is patentable over the cited combination of Furnish and Rammler. As claims 19-20 include the elements of claim 9 and add further limitations, claims 19-20 are patentable. Favorable reconsideration is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

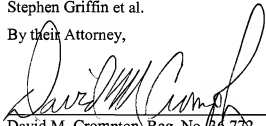
Respectfully submitted,

Stephen Griffin et al.

By their Attorney,

Date: \_\_\_\_\_

11/16/07

  
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